

REMARKS

Claims 1, 2, 4-11, 13-15, 17, 18 and 20-23 are pending in the application.

Claims 1, 2, 4-11, 13-15, 17, 18 and 20-23 have been rejected.

Claim 4 has been amended, as set forth herein, to correct the error in dependency noted by the Examiner. The Examiner is thanked. In light of this amendment, the claim objection is believed obviated.

New claim 24 is added, and is supported, *e.g.*, in paragraphs 0028-0029 of the specification as filed.

I. REJECTION UNDER 35 U.S.C. § 103(a)

Claims 1, 2, 4, 7, 8, 10, 11, 13-15, 17, 18 and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0236574 to *Ativanichayaphon et al*, hereinafter “Wilson” in view of U.S. Patent No. 6,201,562 to *Lor*, hereinafter “Lor” and U.S. Patent Publication 2003/0236906 to *Klemets et al*, hereinafter “Klemets”. The Applicant respectfully traverses the rejection.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. (*Id.* at 1073, 5 USPQ2d at 1598). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007))).

Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. MPEP § 2142, p. 2100-125 (8th ed. rev. 5, August 2006). To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

Independent Claims 1 and 8 each recite limitations similar to those of Claim 15, reproduced below:

identifying, through negotiation with the video client, a CODEC to be used to communicate with the video client; and
retrieving from memory the dynamic multimedia prompt having been encoded using the identified CODEC and stored in the memory thereafter, the dynamic multimedia prompt also having been encoded using a second CODEC different from the identified CODEC and stored in the memory thereafter.

Applicant respectfully submits that none of the three cited references, either alone or in combination, teach, suggest or disclose these features. Based on the Office Action's interpretation, Lor teaches a negotiation process for CODECs to be used by video clients in a communication session. However, it does not appear that disclose or teaches encoding a multimedia prompt (all or a portion thereof) using one CODEC and storing, and encoding the same multimedia prompt using a different CODEC and storing, and after identifying which CODEC is going to be used by the video client, retrieving and corresponding stored prompt (of the two stored versions of the prompt). Therefore, Applicant's claims are not obvious in view of the cited references.

The Examiner responds with reference to Klemets's paragraph 0039, alleging that it teaches the use of different CODECs. The Examiner is incorrect:

[0039] Multiple versions of the same type of media (e.g., multiple audio versions, multiple video versions, etc.) may be included in the media content, allowing selection of different combinations of these streams for playback by media player 142. Each of these different versions is typically encoded at a different bit rate (with higher bit rates typically resulting in higher quality content). Which combination of streams are to be included in the streaming media content can be selected in a variety of manners, such as user preferences (e.g., for higher or lower quality content), available network bandwidth, a desired bit rate for particular content (e.g., a bit rate set by the content author or distributor and included in the identifier of the streaming media content so that, when the identifier is selected by the user, streaming media player 142 selects streams (optionally based on user preferences) that are as close as possible to the desired bit rate).

Klemets only addresses different bit rates for the *same* type of media. Those of skill in the art recognize that different bit rates for a common media type are encoded using the *same* CODEC. That is, an MP3 encoder, for example, can encode audio at a variety different bit rates, but they are all encoded and decoded using a single MP3 CODEC. Klemets does not consider at all encoding the same multimedia prompt using more than one CODEC. Nor does any combination of the references, and all rejections are traversed.

New claim 24 distinguishes from the cited art for similar reasons as those discussed above.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 103 rejection with respect to these claims.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

The Commissioner is hereby authorized to charge \$220.00 for the additional independent claim fee, or any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

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